



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/904,710	07/12/2001	Narasimhaswamy Manjunath	GFN- 5339DV	4467
7590	10/02/2003		EXAMINER	
FINNEGAN HENDERSON FARABOW GARRETT & DUNNER LLP 1300 I STREET NW WASHINGTON, DC 20005-3315			GAMBEL, PHILLIP	
			ART UNIT	PAPER NUMBER
			1644	
			DATE MAILED: 10/02/2003	

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)						
	09/904710 Examiner GAM BEL	Art Unit 1644						
<p align="center">- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -</p> <p align="center">Period for Reply</p>								
<p align="center">A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>1</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.</p> <ul style="list-style-type: none"> - Extensions of time may be available under the provisions of 37 CFR 1.138(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely. - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). - Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b). 								
<p>Status</p> <p>1)<input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>7/10/01; 8/27/01</u></p> <p>2a)<input type="checkbox"/> This action is FINAL. 2b)<input checked="" type="checkbox"/> This action is non-final.</p> <p>3)<input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i>, 1935 C.D. 11, 453 O.G. 213.</p>								
<p>Disposition of Claims</p> <p>4)<input checked="" type="checkbox"/> Claim(s) <u>1, 2, 4, 26-34</u> is/are pending in the application.</p> <p>4a) Of the above claim(s) <u> </u> is/are withdrawn from consideration.</p> <p>5)<input type="checkbox"/> Claim(s) <u> </u> is/are allowed.</p> <p>6)<input type="checkbox"/> Claim(s) <u> </u> is/are rejected.</p> <p>7)<input type="checkbox"/> Claim(s) <u> </u> is/are objected to.</p> <p>8)<input checked="" type="checkbox"/> Claim(s) <u> </u> are subject to restriction and/or election requirement. <u>1, 2, 4, 26-34</u></p>								
<p>Application Papers</p> <p>9)<input type="checkbox"/> The specification is objected to by the Examiner.</p> <p>10)<input type="checkbox"/> The drawing(s) filed on <u> </u> is/are: a)<input type="checkbox"/> accepted or b)<input type="checkbox"/> objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).</p> <p>11)<input type="checkbox"/> The proposed drawing correction filed on <u> </u> is: a)<input type="checkbox"/> approved b)<input type="checkbox"/> disapproved by the Examiner. If approved, corrected drawings are required in reply to this Office action.</p> <p>12)<input type="checkbox"/> The oath or declaration is objected to by the Examiner.</p>								
<p>Priority under 35 U.S.C. §§ 119 and 120</p> <p>13)<input type="checkbox"/> Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a)<input type="checkbox"/> All b)<input type="checkbox"/> Some * c)<input type="checkbox"/> None of: 1.<input type="checkbox"/> Certified copies of the priority documents have been received. 2.<input type="checkbox"/> Certified copies of the priority documents have been received in Application No. <u> </u>. 3.<input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). * See the attached detailed Office action for a list of the certified copies not received.</p> <p>14)<input checked="" type="checkbox"/> Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application). a)<input type="checkbox"/> The translation of the foreign language provisional application has been received.</p> <p>15)<input type="checkbox"/> Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.</p>								
<p>Attachment(s)</p> <table border="0"> <tr> <td>1)<input type="checkbox"/> Notice of References Cited (PTO-892)</td> <td>4)<input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). <u> </u></td> </tr> <tr> <td>2)<input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</td> <td>5)<input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</td> </tr> <tr> <td>3)<input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u> </u></td> <td>6)<input type="checkbox"/> Other: _____</td> </tr> </table>			1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). <u> </u>	2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)	3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u> </u>	6) <input type="checkbox"/> Other: _____
1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). <u> </u>							
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)							
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u> </u>	6) <input type="checkbox"/> Other: _____							

DETAILED ACTION

1. Applicant's amendment, filed 7/12/02 (Paper No. 7), has been entered.

Claims 3 and 5-25 have been canceled.
Claims 1, 2 and 4 have been amended.
Claims 26-34 have been added.

Applicant's amendment, filed 8/27/02 (Paper No. 11), has been entered.

Claims 1 and 28 have been amended.

Claims 1, 2, 4 and 26-34 are pending.

3. Claims 1-2 link Inventions I-VI. The restriction requirement among the linked inventions is subject to the nonallowance of the linking claim(s), claims 1-2. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

The claims encompass PSGL antagonist which do not share a substantial structural feature essential to a common utility. The claims encompass PSGL antagonists selected from the group consisting of PSGL, PSGL-specific antibody, sLex-specific antibody, sulfated tyrosine-specific antibody, mimetics which inhibit sLex binding and small molecule inhibitors of PSGL binding.

4. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1-2; drawn to methods of inhibiting T cell cytotoxicity with soluble PSGL-1, classified in Class 514, subclass 8.

II. Claims 1-2, 4 and 26-34; drawn to methods of inhibiting T cell cytotoxicity with PSGL-specific antibodies, classified in Class 424, subclass 130.1.

III. Claims 1-2; drawn to methods of inhibiting T cell cytotoxicity with sLex-specific antibodies, classified in Class 424, subclass 137.1.

IV. Claims 1-2; drawn to methods of inhibiting T cell cytotoxicity with sulfated tyrosine-specific antibodies, classified in Class 424, subclass 152.1.

V. Claims 1-2; drawn to methods of inhibiting T cell cytotoxicity with mimetics which inhibit sLex binding classified in Class 514, subclass 12.

VI. Claims 1-2; drawn to methods of inhibiting T cell cytotoxicity with small molecule inhibitors of PSGL binding, classified in Class 514, subclass 885.

5. Inventions I-VI are different methods, which require patentably distinct ingredients and method steps. Therefore, they are patentably distinct.

As indicated above, the claims encompass methods employing ingredients encompassing PSGL antagonists which do not share a substantial structural feature essential to a common utility. The claims encompass PSGL antagonists selected from the group consisting of PSGL, PSGL-specific antibody, sLex-specific antibody, sulfated tyrosine-specific antibody, mimetics which inhibit sLex binding and small molecule inhibitors of PSGL binding.

6. Because these inventions are distinct for the reasons given above and the search required for any Group from Groups I-VI is not required for any other group from Groups I-VI and Groups I-VI have acquired a separate status in the art because the searches are not co-extensive and encompass divergent subject matter, restriction for examination purposes as indicated is proper.

7. This application contains claims directed to the following patentably distinct species of the claimed Group II (and Groups I and III-VI): wherein the disease or condition is:

- A) autoimmune,
- B) allergy, or
- C) asthma.

These species are distinct because their etiologies and therapeutic endpoints are differ. Therefore, they are separate and patentably distinct species issues in determining patentability.

If applicant intends to include viral infections or combating tumors as disclosed on page 34 of the instant specification, then these diseases or conditions would be subject to an election of species.

It is noted that claims directed to Groups I and III-VI do not recite "diseases or conditions" per se. However, if applicant does elect one of the Groups selected from Groups I and III-VI, then applicant must elect one of the species indicated herein.

Applicant is required under 35 U.S.C. § 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-2 are generic.

8. Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. § 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. M.P.E.P. § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103 of the other invention.

9. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

10. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phillip Gambel whose telephone number is (703) 308-3997. The examiner can normally be reached Monday through Thursday from 7:30 am to 6:00 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.

Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone number is (703) 872-9306.

Phillip Gambel
Phillip Gambel, PhD.
Primary Examiner
Technology Center 1600
September 23, 2003